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10/018,469	02/04/2002	Patrick Alexandre	111504	1617

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Oliff & Berridge
PO Box 19928
Alexandria, VA 22320

EXAMINER

WILLIAMS, CATHERINE SERKE

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,469

Applicant(s)

ALEXANDRE ET AL.

Examiner

Catherine S. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/13/06.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8 and 10 is/are rejected.
- 7) ☒ Claim(s) 4,9 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The objection to figure 2 in the previous office action dated 3/31/06 has been withdrawn in light of the remarks filed 6/13/06. Specifically, the objection is overcome due to the reference to page 5 line 6 of the specification which in general states that the principle can partially fill the cavity.

However, the drawings filed 7/22/04, specifically figure 3, are objected to under 35 U.S.C. 132(a) because they introduce new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

1. Figure 3 introduces new matter in showing three cavities that are partially filled with the active principle. The original disclosure only mentions that there is at least one cavity but does not support three cavities or the arrangement of three cavities within the barrier.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5,8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanford et al. (USPN 4,945,050). Sanford discloses a propelling system (trigger and explosive charge) including a shock wave generating device (55), an application guide (54) and a barrier (50) with a blind cavity (53) accommodating an active principle (52). See figures 8a-8b and 8:52+. As shown in figure 8a, the upstream face of the barrier is in contact with the shock wave generator (55). The application guide includes a shock absorbing system (58).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford. Sanford meets the claim limitations as described above but fails to include a plurality of cavities being distributed on the downstream face of the barrier.

At the time of the invention, it would have been an obvious design choice by one skilled in the art to incorporate more than one cavity into the barrier. Applicant has not disclosed that more than one cavity solves a particular problem, is used for a particular purpose or provides an advantage. Furthermore, one skilled in the art would have incorporated more than one cavity as an obvious way to administer a larger dose of active agent to the patient. One would expect a barrier with one cavity and a barrier with more than one cavity to perform equally well with the

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multiple cavity barrier delivering a larger quantity of active agent in order to reduce the number of times the patient would need to be injected with the principle to achieve a larger dose.

Response to Arguments

The examiner has reviewed the entirety of the application and all documents on file in light of applicant's comments in the reply filed 6/13/06. The examiner has also submitted the application for review by the examiner's supervisor as was requested by Applicant.

Applicant's arguments regarding the drawings filed 6/13/06 have been fully considered and are persuasive with regard to figure 2 but they are not persuasive with regard to figure 3. Applicant argues that support for figure 3 can be found on page 6 lines 21-23 of the specification that states the barrier may have a plurality of cavities. While the specification discloses a plurality of cavities, the drawing contains new matter in that a specific number of cavities are shown, i.e. three, and a specific configuration of the cavities is depicted. Neither the number nor the configuration is disclosed in the specification.

Additionally, applicant asserts that the examiner has not provided guidance as to how Applicant could overcome the drawing objection(s). However, during at least one telephone conversation between the examiner and applicant's attorney, it was suggest that applicant could either cancel figure 3 and claim 6 or applicant could file a continuation in part. Applicant's attorney was not receptive to either of these suggestions. Both courses of action are hereby suggested again.

Applicant's arguments with respect to the claims filed 6/13/06 have been considered but are not persuasive. Applicant argues that Sanford does not teach a resistant barrier which

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ensures a good propagation of the shock wave. However, the barrier (50) ensures a good propagation of the shock wave in the fact that the particles are released from the barrier.

Applicant further states that “Sanford is not intended to allow the shock wave to propagate, i.e. travel through it.” However, “travel through it” is not language used in claim 1. The term “propagate” is broad and must be interpreted as such minus some additional claim language or further definition in the specification. Furthermore, the claims are interpreted in light of the specification; however, limitations from the specification are not read into the claims. Finally, one would not find the above rejection or interpretation unreasonable in light of the fact that the prior art device and the instant invention result in the same outcome.

The examiner agrees that prosecution of the application has been challenging. However, presently claims 4, 9 and 12 contain allowable subject matter and if incorporated into the independent claim would place the application into condition for allowance.

Allowable Subject Matter

Claims 4,9 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine S. Williams whose telephone number is 571-272-4970. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine S. Williams
October 8, 2006

CATHERINE S. WILLIAMS
PRIMARY EXAMINER